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V.S.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/907,687 08/08/97 SABOURIN M AZNDR/346/US

IM62/1108

EXAMINER

ALIX, YALE & RISTAS, LLP
750 MAIN STREET
HARTFORD CT 06103-2721

ALVO, M

ART UNIT PAPER NUMBER

1731

DATE MAILED:

11/08/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/907,687	Applicant(s) SABOURIN
	Examiner Steve Alvo	Group Art Unit 1731

Responsive to communication(s) filed on Aug 12, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1-3, 5, 7, and 15-30 is/are pending in the application.

Of the above, claim(s) 16-22 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-3, 5, 7, 15, and 23-30 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 13

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5, 7, 15 and 23-30 are rejected under ~~35 U.S.C. 102(b) as anticipated by or, in the alternative,~~ under 35 U.S.C. 103(a) as obvious over PRUSAS et al with or without LUNAN et al or PCT 96/41914.

PRUSAS et al (column 4, lines 42-49) teaches conditioning fiber containing material at an elevated temperature and pressure with steam (column 8, lines 17-30) compressing the chips to a ratio of 3/1 to 5/1 (column 3, lines 14-15 and 36-38 and paragraph bridging columns 3-4) and chemically "refining" the chips (Fig. 5 for Kraft pulping process and column 8, lines 9-12 for refining the chips). It would have been obvious to the artisan that the high temperature steaming of PRUSAS et al would be under pressure. If this is not obvious then such would have been obvious from the teachings of LUNAN et al which teaches using high pressures (225-620 kPa or 32-90 psi) in the presteaming stage for short periods of time (16 seconds) to prevent discoloring of the pulp (see Abstract) prior to a pulp refining process (TMP). Or obvious to use high temperatures and short steaming times (10-30 seconds) as taught by PCT 96/41914

Claims 1-3, 5, 7, 15, 23-28 and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to

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reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The terms "at least 10 psi" and "at least about 120 deg. C" were not disclosed. The instant specification disclosed using a pressure of "10-100 psi". The term "at least 10" includes values greater than "100" which is outside the disclosed range. Claim 28 is rejected as the range "30-100 psi" was not disclosed. There is no disclosure indicating any significance with the claimed 30 psi.

The restriction requirement of Paper No. 7 was made Final in Paper No. 11.

The argument that the prior art does not teach deconstructuring the fibers without significant breakage across grain boundaries is not convincing. The "deconstructuring the fibers without significant breakage across grain boundaries" is a direct result of the "conditioning" of the fibers. The same "conditioning" is taught by the applied art. At best Applicant is optimizing the "conditioning" of the prior art. There is a reasonable expectation that the conditioning of the prior art would yield a feed material having the desired amount of deconstructuring. *In re O'Farrel*, 7 USPQ2d 1673, 1680-81. In any event, it is well settled that an artisan with ordinary skill would have found it obvious to determine workable or even optimum values for an art recognized, result effective parameter, such as the proper amount of compression, *In re Boesch*, 205 USPQ 215, 219; *In re Aller*, 105, USPQ 233, 235.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

When filing an "**Official**" FAX in Art Unit 1731, please indicate in the Header (upper right) "**Official**" for papers that are to be entered into the file. The "**Official**" FAX phone number for this Art Unit is **(703) 305-7718** for all papers except amendments after final, for amendments after final the FAX number is 703-305-3599. When filing an "**Unofficial**" FAX in Group 1730, please indicate in the Header (upper right) "**Unofficial**" for Draft Documents and other Communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers. The "**Unofficial**" FAX phone number for this Art Unit (1731) is **(703) 305-7115**.

Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is **(703) 308-2048**. The Examiner can normally be reached on Monday - Friday from **6:30 AM - 3:00 PM (EST)**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is **(703) 308-0661**.



STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731

MSA
November 8, 1999